

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Wolfgang RUF et al. Confirmation No.: 2423
Appln. No : 10/072,876 Group Art Unit: 1731
Filed : February 12, 2002 Examiner: J. Fortuna
For : LAMELLA OF A HEADBOX OF A PAPER, CARDBOARD OR
TISSUE MACHINE

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop **AF**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir :

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of June 1, 2006.

While no fees are believed necessary to ensure consideration of the instant Request, should any fees be deemed necessary, the undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

A prima facie case of anticipation has not been set forth, such that the Rejection Under 35 U.S.C. § 102(b) is improper. Moreover, a prima facie case of unpatentability has not been set forth, such that the Rejection Under 35 U.S.C. § 103(a) is also improper.

Examiner's Assertion:

The term "integrally formed" is unclear within the context of the instant application so as to render the claims improper under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 112, second paragraph.

Applicants' Reply:

Applicants submit that support for the term "integrally formed" can be found in the originally submitted drawings, particularly Figures 3a and 3b, as originally submitted. A review of these original figures reveals that the lamella and the structures formed in the lamella surface are formed as one piece. It is apparent these original figures reveal the lamellas and structures formed in or on the lamella surface are formed as one piece, and hence, integrally formed.

Therefore, Applicants submit the original disclosure supports Applicants claims reciting structures formed in or on the surface of the lamella are formed in one piece with each other, such that these structures are integrally formed in or on the surface of the lamella. Moreover, as support for the term "integrally formed" is found in the originally submitted disclosure, it is apparent that the inventors did have possession of this subject matter at the time of the invention, such that the Examiner's assertions to the contrary are improper.

While the Examiner has provided various definitions of "integral" to support his assertions, see Advisory Action, it is apparent that, when read in the context of the instant application and amended claims, only the definition "a complete unit, a whole" has any reasonable relation to the invention. Moreover, Applicants have proffered this meaning in prior responses, such that reconsideration of the prior art in view of the clear and unambiguous recitation of integrally formed is requested.

In view of the foregoing, Applicants refer the panel to, e.g., paragraph [0064] of

Applicants' specification, which states "structured lamella end 11.1 may be *embodied or formed with a grooved structured surface 22*." Thus, as the disclosure provides that the lamella is *formed* with a grooved structure, it is clear the inventors possessed the feature of the grooved structure formed as part of the lamella at the time of the invention, and this disclosure provides sufficient support for the recitation "integrally formed" in the pending claims.

Further, Applicants submit one ordinarily skilled in the art reviewing the original disclosure and the pending claims would understand that structures formed in or on the lamella surface are formed in one piece with the lamella. Moreover, Applicants submit the original figures show the lamellas and the structures formed in or on the lamella surface are formed as one piece. Moreover, as, e.g., paragraph [0064] of Applicants' specification provides support for a recitation of "integrally formed," ("structured lamella end 11.1 may be *embodied or formed with a grooved structured surface 22*"), one ordinarily skilled in the art would readily understand the invention and be able to ascertain the scope of the claims.

Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of claims 1 – 53 under 35 U.S.C. § 112, second paragraph, and indicate the claims are fully in compliance with the requirements of the statute.

Examiner's Assertion:

The Examiner asserts that RUF shows all of the recited features, including a structure 9.6 in lamella 8.6, as shown in Figure 6.

Applicants' Reply:

As Applicants have maintained, any "structures" formed in RUF are *added* to the lamella, and not *integrally formed*, as recited in at least independent claims 1, 22, and 42. Thus, Applicants submit RUF fails to disclose at least the above-noted features of the present invention.

Applicants note the Examiner has not considered the recited term "integrally formed" in the examination of the prior art, but instead has ignored this feature based upon the pending, and improper, formal rejections under 35 U.S.C. § 112. Applicants submit, notwithstanding the formal issues, the Examiner cannot simply ignore expressly recited features of the claims because a purported formal issue is concurrently involved with

terminology, unless such terminology renders examination impracticable. As the terminology at issue is directed to a common term that would have been readily understood by those ordinarily skilled in the art, the Examiner's consideration of the prior art must include the structures "integrally formed" in or on the surface of the lamella.

Moreover, in contrast to the instant invention, which includes a lamella as a unitary element having structures formed in or on the lamella surface, Figure 6 of RUF shows a "structure," as identified by the Examiner, *attached* to the lamella, not integrally formed. As a result, Applicants submit RUF fails to provide any disclosure of lamella having structures integrally formed, i.e., in one piece with, in or on the lamella surface, as recited in at least independent claims 1, 22, and 44.

Because RUF fails to disclose at least the above-noted feature, Applicants submit that this document fails to disclose each and every recited feature of the instant invention. Thus, Applicants submit that the RUF fails to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b) and that the instant rejection should be withdrawn.

Examiner's Assertion:

The Examiner asserts that, while RUF does not disclose a grooved surface, it would have been obvious to include such a surface in view of the disclosure of SANFORD

Applicants' Reply:

While arguably showing integrally formed structures formed in an upper surface of the lamella, SANFORD fails to provide any teaching or suggestion that it would have been obvious to modify RUF to include integrally formed structures. That is, RUF adds additional elements to lamella to form projections and overhanging portions, and it is not apparent these portions can be formed in an integrally formed element, such that it is not apparent it would have been obvious to modify RUF in the manner asserted by the Examiner.

Further, as SANFORD fails to provide any teaching or suggestion the recited portion coupled to and sloped relative to a first surface, and a second surface, located opposite said first surface, provided with a structured end *adjacent said sloped portion* and having at least one structure integrally formed in or on said second surface, this document fails to

provide the requisite motivation or rationale to modify RUF in any manner that would render the instant invention unpatentable.

Because neither applied document teaches or suggests at least one structure integrally formed in or on the second surface adjacent the sloped portion, no proper combination of these documents can render unpatentable the instant invention. Thus, Applicants submit that no proper combination of the applied art can render unpatentable the combination of features recited in at least independent claims 1, 22, and 44.

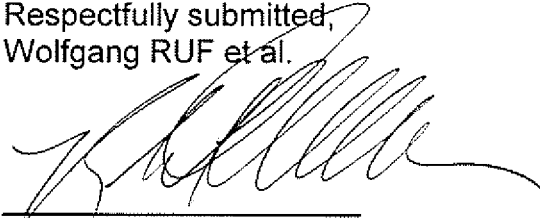
Moreover, Applicants submit the applied documents conflict with each other in that, SANFORD uses a grooved lamella tip, while RUF expressly discloses tip t (at the end of the lamella) should be as exactly straight-lined as possible from side wall to side wall, i.e., it should be *as close as possible to parallel to the outlet ends*, see RUF, column 4, lines 16 - 23. As these documents disclose conflicting information, Applicants submit no reasonable basis for combination exists.

CONCLUSION

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Wolfgang RUF et al.



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September 1, 2006
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